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In the Supreme Court of the United States

OCTOBER TERM, 1969

STANDARD INDUSTRIES, INC., PETITIONER

v.

TIGRETT INDUSTRIES, INC., ET AL.

ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT

BRIEF FOR UNITED STATES AS AMICUS CURIAE

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OPINIONS BELOW

The opinion of the United States District Court for the Western District of Tennessee (App. 37a–46a; 162 U.S.P.Q. 32)[1] is not officially reported. The court of appeals' opinion (App. 53a9–53a11) is reported at 411 F. 2d 1218.

JURISDICTION

The judgment of the court of appeals was entered on May 27, 1969. The petition for a writ of certiorari was filed on August 8, 1969, and was granted on October 27, 1969. The jurisdiction of this Court rests on 28 U.S.C. 1254(1).

[1] "App." refers to the Appendix filed by the petitioner in this Court.

QUESTION PRESENTED

The United States will discuss the following question, which is fairly comprehended within Point III of the petition and Question 2 of petitioner's brief on the merits:

Whether the judicially-created doctrine of equivalents, applied by the courts below, conflicts with basic policies of the federal patent system and should therefore be rejected or fundamentally revised as a standard of patent infringement.[2]

INTEREST OF THE UNITED STATES

The doctrine of equivalents permits a patent owner to enforce monopoly power over devices related to the subject of his patent even though not expressly within the scope of the claims of his patent and, therefore, not within the scope of the limited monopoly to which the Patent Office has ruled he is entitled. The result is to leave the patent owner's competitors and the general public uncertain as to the boundary between permissible enterprise and impermissible infringment, thus hindering the creative enterprise of both. We believe that this result is contrary to the balance achieved in the Constitution and the patent statutes between the general social and economic policy favoring free competition and the policy of granting a limited reward to inventors in order to promote the progress of science and the useful arts. Indeed, we believe that the

[2] The United States intimates no view with respect to the parties' contentions on other questions not discussed in this brief.

doctrine of equivalents, as it has been judicially developed, hinders, rather than promotes, the technological progress that is the goal of the system. The importance of the issue to the national economy and to the proper functioning of the federal patent system has led the United States to file this brief *amicus curiae*.

STATEMENT

The principal facts relevant to the equivalents issue are set out in the opinions of the district court (App. 37a–46a) and of the court of appeals (App. 53a9–53a12). Respondent John B. Tigrett licensed respondent Tigrett Industries, Inc., to use his patent (U.S. Patent No. 3,162,865) on a children's play pen in return for continuing royalties (App. 41a–43a, 53a10). Petitioner succeeded to this license by assignment (App. 42a, 54a–63a). Under the assignment agreement, petitioner was obligated to pay royalties to the respondents on "covered products" that petitioner manufactured utilizing the patent (App. 62a). Petitioner subsequently refused to pay royalties on certain play pens it produced, contending that they were not "covered products" within the scope of the patent grant (App. 41a–44a, 53a10). Respondents then brought this suit against petitioner for royalties allegedly due.

Claim One of the patent reads as follows:

> An article of infant furniture comprising a top frame member, a base plate, a flexible netting having a general tubular form suspended from said top frame member, and extending

> downwardly for receiving the said base plate and presenting same in normal planar relation to the axis of said tubular netting, said netting at its lower end extending inwardly beneath said base plate, drawstrings engaged to the lower end edge of said netting beneath said base plate, *said base plate having a pair of spaced openings,* said drawstrings being threaded upwardly through said openings in said base plate and being mutually fixedly engaged above said base plate for providing a grip for convenient manipulation for said netting to elevate said base plate by upward pulling on said grip, a bottom frame member in planar parallel relation to said top frame member and disposed below said base plate for support thereof, legs engaged at their upper ends to said top frame member and extending downwardly therefrom, and means for engaging said bottom frame member to said legs [Emphasis supplied].

Petitioner's main contention was that the play pen in question was not within Claim One of the patent because its base plate had only a single opening instead of "a pair of spaced openings" as specifically described in the Claim (App. 44a).

The district court held that petitioner's play pen was covered by the patent, notwithstanding the difference in structure. It ruled that the doctrine of equivalents was "applicable here because the two structures work in substantially the same way and with the same result" (App. 44a). Accordingly, the court held that respondents were entitled to recover the unpaid royalties (App. 45a–46a).

In a *per curiam* opinion, the court of appeals affirmed the district court's decision (App. 53a9–53a11).

INTRODUCTION AND SUMMARY OF ARGUMENT

Patent monopolies are narrowly delimited exceptions to the competitive free-enterprise system.[3] The Patent Clause of the Constitution and the patent statutes carefully restrict the scope of patent monopolies and the method by which they may be achieved, so as to allow and encourage the exploitation of science and the useful arts by the public. The doctrine of equivalents undermines this policy by permitting judicial expansion of patent monopolies beyond the scope granted by the Patent Office and upheld as valid in the judicial proceedings themselves—since both issuance and validity are, in accordance with the statutory scheme, determined on the basis of the patentee's claims, but the doctrine of equivalents has not been so limited. By thus broadening the area foreclosed from public use by a patent, the doctrine discourages inventive efforts and commercial enterprise by the patentee's competitors and confers competitive advantage on the patentee in contravention of statutory requirements.

This case presents an appropriate occasion for reexamination by this Court of the validity of the doctrine of equivalents. Although the Court sustained

[3] See, *e.g.*, *Lear, Inc.* v. *Adkins*, 395 U.S. 653, 663; *Graham* v. *John Deere Co.*, 383 U.S. 1, 5–6; *Sears, Roebuck & Co.* v. *Stiffel Co.*, 376 U.S. 225, 229–231.

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the doctrine twenty years ago in *Graver Tank & Mfg. Co.* v. *Linde Air Products Co.*, 339 U.S. 605, that decision failed to give adequate weight to the statutory changes which have occurred since the doctrine's origins, and is antithetical to federal patent policy as articulated by this Court in important, more recent decisions. Since the holding of the courts below that petitioner infringed[4] respondent's patent is dependent upon the validity of the principles of *Graver*, and since petitioner has broadly challenged the application here of the equivalents doctrine at every stage of the proceedings (cf. *Lear, Inc.* v. *Adkins, supra*, 395 U.S. at 662 n. 10), the occasion is appropriate for this Court to reconsider the premises of the *Graver* decision.

We shall show first that the doctrine of equivalents, as presently interpreted, subverts the federal patent policy defined by the Constitution, the patent statutes and decisions of this Court. We shall then show that the legitimate rights of patentholders can adequately be protected by the courts and by administrative procedures provided for by statute, without resort to judicial expansion of patent monopolies through use of the equivalents doctrine. Our conclusion is that rejection of the doctrine, in favor of a test of infringement more specifically focused on the patentees' claims, would properly vindicate federal patent policy without hindering appropriate equitable adjustment of any conflict between the patentees' rights and the public

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[4] Although petitioner is in effect a licensee, the parties agreed in the district court that the issue was essentially the same as infringement (App. 43a).

interest in encouraging competition and furthering technological progress.

ARGUMENT

I

THE DOCTRINE OF EQUIVALENTS CONFLICTS WITH THE DOMINANT POLICIES OF THE FEDERAL PATENT SYSTEM

The Patent Clause of the Constitution authorizes Congress "To promote the Progress of Science and useful Arts, by securing for limited Times to * * * Inventors the exclusive Right to their * * * Discoveries." Art. I, § 8, cl. 8. The statutory system devised to give effect to the Patent Clause reflects congressional balancing, on the one hand, of an interest in conferring a competitive advantage on inventors in order to encourage and reward invention and disclosure thereof, with, on the other hand, the more pervasive policies of fostering competition and encouraging the economic exploitation of knowledge and technology by the public. In *Universal Oil Products Co.* v. *Globe Oil & Refining Co.*, 322 U.S. 471, 484, this Court explained the reasoning underlying the statutory scheme as follows:

> As a reward for inventions and to encourage their disclosure, the United States offers a seventeen-year monopoly to an inventor, who refrains from keeping his invention a trade secret. But the *quid pro quo* is disclosure of a process or device in sufficient detail to enable one skilled in the art to practice the invention once the period of the monopoly has expired: and the same precision of disclosure is likewise

essential to warn the industry concerned of the precise scope of the monopoly asserted.

Congress has defined in detail the conditions that must be met to warrant the grant of a patent monopoly as a carefully-limited departure from the competitive norm. First, a patent may be granted only to one who invents or discovers a new and useful product or process (35 U.S.C. 101). Second, a patent grant is prohibited if the alleged invention had previously been known or used by another (35 U.S.C. 102). Third, the subject matter must not be obvious to those skilled in the art (35 U.S.C. 103). And, of principal importance in the present context, the inventor must fully define and explain the product or process he claims as his invention. That is, the invention and its use must be described in such "full, clear, concise, and exact terms" that the public is taught how to make and use it; moreover, the subject matter of the invention must be particularly pointed out and distinctly claimed in the patent claims (35 U.S.C. 112).

[illegible] THE STATUTORY REQUIREMENT OF PRECISE CLAIMING IS DESIGNED [illegible] THE PUBLIC FROM UNFOUNDED ASSERTIONS OF [illegible] POWER.

"The requirement of specificity in Section 112 and its predecessors serves a dual policy—to insure defi-

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16 Stat. 201 (1870); Rev. Stat. 4888 (1878), as amended, 38 Stat. 958 (1915); 35 U.S.C. 33 (1946). For an example of judicial enforcement of this statutory requirement, see *Hallibur-ton Co. v. Walker*, 329 U.S. 1. And see *White v. Dunbar*, 119 U.S. 47, 51–52.

cation of the invention to the public at the expiration of the statutory monopoly period and to notify the public of the boundaries of the monopoly during its life so that the patentee's competitors may distinguish between impermissible infringement and permissible enterprise. This Court explained these policies in *General Electric Co.* v. *Wabash Appliance Corp.*, 304 U.S. 364, 369:

> The limits of a patent must be known for the protection of the patentee, the encouragement of the inventive genius of others and assurance that the subject of the patent will be dedicated ultimately to the public. The statute seeks to guard against unreasonable advantages to the patentee and disadvantages to others arising from uncertainty as to their rights. The inventor must "inform the public during the life of the patent of the limits of the monopoly asserted, so that it may be known which features may be safely used or manufactured without a license and which may not."

Accordingly, by relying on the description of the invention disclosed in the patent claims, competitors are free to "invent around" the claimed subject matter of the patent in order to compete technologically with the patentee without the burden of royalty payments. Competition in innovation is thus encouraged notwithstanding the governmental grant of a monopoly to the patentee.

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[1] See *Chicago Steel Foundry Co.* v. *Burnside Steel Foundry Co.*, 132 F. 2d 812, 816 (C.A. 7); *James P. Marsh Corp.* v. *United States Gauge Co.*, 129 F. 2d 161, 165 (C.A. 7).

Consistent with the mandate of Section 112 for precise claims is the basic tenet of the federal patent system that the patent claims are the sole measure of the scope of the monopoly granted. *Aro Mfg. Co. v. Convertible Top Co.* ("*Aro I*"), 365 U.S. 336, 339–340; *Universal Oil Products Co. v. Globe Oil & Refining Co.*, *supra*, 322 U.S. at 484.[1] In *Universal Oil Products* this Court stated the reason for the rule as follows: "The claim is the measure of the grant. * * * The claim is required to be specific for the very purpose of protecting the public against extension of the scope of the patent." 322 U.S. at 484–485. The Court emphasized that the claims serve as a warning to the industry concerned of the scope of the patent monopoly (*id.* at 484) so that competitors' reliance on the claims is protected and encouraged.

It follows that whatever is not specifically claimed in a patent is dedicated or renounced to the public. *Marconi Wireless Co. v. United States*, 320 U.S. 1, 23; *Sinclair Stoves Co. v. Vat Co.*, 310 U.S. 281, 289–290; *Minerals Separation v. Butte Mining Co.*, *supra*, 250 U.S. at 347. "[P]atentees cannot show that their invention is broader than the terms of their claim; or if broader, they must be held to have surrendered the surplus to the public" (*Keystone Bridge Co. v. Phoenix Iron Co.*, 95 U.S. 274, 278).

B. THE DOCTRINE OF EQUIVALENTS IS INCONSISTENT WITH THE PURPOSES OF THE STATUTORY REQUIREMENT OF PRECISE CLAIMING

The judicially-created doctrine of equivalents runs counter to the statutory requirement that the subject

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[1] See, also, *Milton Steel Co. v. Fuller Co.*, 316 U.S. 143; *Minerals Separation v. Butte Mining Co.*, 256 U.S. 336.

of a patent be precisely defined in the patent claims. Under the doctrine of equivalents, a device not covered by the claims of a patent may nevertheless fall within the patent monopoly if a court concludes that the allegedly infringing device "performs substantially the same function in substantially the same way to obtain the same result." *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 339 U.S. 605, 608 (quoting *Sanitary Refrigerator Co. v. Winter*, 280 U.S. 30, 42). The Court in *Graver* further explained (339 U.S. at 608): "The theory on which [the doctrine] is founded is that 'if two devices do the same work in substantially the same way, and accomplish substantially the same result, they are the same, even though they differ in name, form, or shape.' *Machine Co. v. Murphy*, 97 U.S. 120, 125."

As a standard for judicial determination of infringement, therefore, the doctrine puts in issue a range of inquiry that goes far beyond the terms of the claim, for "'[w]hat constitutes equivalency must be determined against the context of the patent, the prior art, and the particular circumstances of the case'" *Graver*, 339 U.S. at 609). Indeed, the *Graver* opinion further specifies (339 U.S. at 609) that "'[a]n important factor is whether persons reasonably skilled in the art would have known of the interchangeability of an ingredient not contained in the patent with one that was'"—so that the inquiry under the equivalents doctrine tends to approximate a consideration of whether, in light of the teachings of the patent, the allegedly infringing device was sufficiently obvious to

one skilled in the technology to preclude its own patentability. As formulated by this Court, therefore, the doctrine of equivalents authorizes judicial expansion of patent monopolies significantly beyond the dimensions granted by the Patent Office or upheld as valid in judicial review of the grant—since both the administrative issuance of patents and the determination of patent validity are focused on the patentee's claims, rather than on the broad range of "equivalents" which might also be foreclosed by the patent.

If the equivalents doctrine thus seems surprisingly incompatible with the principle that the claims are the sole measure of the monopoly granted and with the statutory requirements of definitive claiming and of expert administrative issuance of patent monopolies (as well as with other aspects of the statutory scheme, see *infra*, pp. 19–22), the explanation is probably historical. As the Court noted in *Graver* (339 U.S. at 608), the doctrine originated in this Court's closely divided 1854 decision in *Winans* v. *Denmead*, 15 How. 330. The Court in *Graver* failed to note, however, that *Winans* was decided under the significantly different statutory scheme of the 1836 patent law, which did not require specificity in claiming (see 5 Stat. 117)—and was decided more than a half century before the enact-

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For examples of the difficulties in determining infringement in cases involving patents with vaguely worded claims during this early period (difficulties which undoubtedly contributed to judicial evolvement of the equivalents doctrine), see *Evans* v. *Eaton*, 3 Wheat. 454, 456–461 (note *a*); *Hogg* v. *Emerson*, 6 How. 436, 438–441; *Burr* v. *Duryee*, 1 Wall. 531, 542–545, 547–548, 567–568.

ment of the first federal antitrust laws, which added a new dimension to the interpretation of patent statutes by making it clear that they provide for only a narrowly delimited exception to the dominant federal policy favoring competition (see p. 5 and n. 3, *supra;* cf. The Statute of Monopolies, 21 Jac. I, c. 3). Such considerations are perceptively reflected in an opinion in which Judge Learned Hand recognized forty years ago that the *Winans* doctrine of equivalents had become an anachronism difficult to reconcile with subsequent statutory mandates (*Claude Neon Lights* v. *E. Machlett & Son*, 36 F. 2d 574, 575 (C.A. 2)):

> [The doctrine of equivalents was based] upon the theory that the claim was not intended to be verbally definitive, but to cover the "invention" which should, to some extent anyway, be gathered from the disclosure at large.
>
> It is plain that such latitude violates in theory the underlying and necessary principle that the disclosure is open to the public save as the claim forbids, and that it is the claim and that alone which measures the monopoly. * * *

Not only do the premises of the equivalents doctrine contradict fundamental principles of the statutory patent system, but the doctrine's economic impact tends to undermine the paramount public interest in competitive technological advancement reflected in that system. That public interest, and not private reward, is the dominant factor to be considered in adjusting conflicts over the scope of patent

monopolies. *Graham* v. *John Deere Co., supra.*[9] Vindication of this important public interest is dependent upon the statutory policy that the boundaries of the patent must be clearly delineated so that rivals of the patentee or newcomers to the field (1) may so adjust and conduct their business operations as to avoid undesired infringement of the grant, and (2) are encouraged to develop alternative technology by "inventing around" the monopoly (see *supra,* pp. 8–10).

The doctrine of equivalents is an obstacle to the economic implementation of this statutory policy. It prevents competitors seeking to invent around the subject of a patent from relying, as Congress intended, on the patent claims themselves to define the scope of the area foreclosed from their use. Because of the difficulty of forecasting how expansively courts might be willing to apply patents under the doctrine, invention around can be accomplished only at a substantial risk of infringement. Yet, as this Court unanimously recognized in a decision enforcing the "statutory requirement of particularity and distinctness in claims," such a result is precisely what Congress sought to avoid because "[a] zone of uncertainty which enterprise and experimentation may enter only at the risk of infringement claims would discourage invention only a little less than unequivocal foreclosure of the field." *United Carbon Co.* v. *Binney Co.,* 317 U.S. 228, 236; cf. *Brenner* v. *Manson,* 383 U.S. 519, 534. See, also, *Aro I, supra,* 365 U.S. at 358–359 (Mr. Justice Black, concurring).

[9] See, also, *United States* v. *Masonite Corp.,* 316 U.S. 265, 278.

In other words, by expanding the economic impact of patents beyond the terms of their claims, the doctrine of equivalents reaches into the area renounced to the public by the patentee—reaches into the public domain (where presumably no patent could have been secured)—and permits royalties to be exacted on the use of that which is the property of all. Cf. *Lear, Inc.* v. *Adkins, supra; Sears, Roebuck & Co.* v. *Stiffel Co., supra; Compco Corp.* v. *Day-Brite Lighting Inc.*, 376 U.S. 234.

The conflict between the doctrine of equivalents and the foregoing considerations has contributed to the growth of the doctrine of file wrapper estoppel, which was summarized by this Court in *Graham* v. *John Deere Co., supra*, 383 U.S. at 33, as follows: "* * * [c]laims that have been narrowed in order to obtain the issuance of a patent by distinguishing the prior art cannot be sustained to cover that which was previously by limitation eliminated from the patent." File wrapper estoppel has become an important limitation on the application of the doctrine of equivalents. "[W]here a patentee has narrowed his claim, in order to escape rejection [by the Patent Office Examiner], he may not 'by resort to the doctrine of equivalents, give to the claim the larger scope which it might have had without the amendments which amount to disclaimer.'" *Smith* v. *Magic City Kennel Club, Inc.*, 282 U.S. 784, 790.

We submit that the reasoning underlying the doctrine of file wrapper estoppel should not be confined solely to those circumstances where, in response to a

rejection by the Patent Office, the patentee amended his claims to secure his patent grant. Even where the original claims are allowed without amendment, the patent monopoly should be confined to what the claims disclose. A patentee who originally confines his claim to avoid prior art, and thus escapes a rejection, should stand in the same position as one who has gone through the formal amending process. In both cases the claims have been narrowly defined in order to avoid rejection and induce a grant.[10] In both cases "the claims made in the patent are the sole measure of the grant" (*Aro I, supra,* 365 U.S. at 339) and, if the theory of the patent law is to be implemented as an economic reality, the claims should also be the guiding measure of the scope of the judicially enforceable patent monopoly.

Our submission, therefore, is that, because it authorizes judicial enforcement of broader patent monopolies than those measured by the claims, the doctrine of equivalents, as it was explicated in *Graver Tank,* should now be rejected by this Court as irreconcilable with fundamental principles of congressional patent policy. We do not mean by this that patentees should no longer be protected against imitations which involve only colorable or trivial deviation from the literal terms of the patent claims. We recognize the wisdom of the Court's observation in *Graver Tank* that

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[10] The drafting of patent claims is a "highly developed art" (see *Brenner* v. *Manson*, *supra*, 383 U.S. at 534) engaged in by certified experts (see *Sperry* v. *Florida*, 373 U.S. 379, 390–402).

"[o]utright and forthright duplication is a dull and very rare type of infringement" (339 U.S. at 607), and we note that dissent within the Court to perpetuation of the equivalents doctrine has not taken the form of advocacy that forbidden infringement be limited to carbon copying (see, *e.g.*, the concurring opinion of Mr. Justice Black in *Aro I*, 365 U.S. at 354–355). Indeed, we favor reaffirmation of the general principle that inventors should not be placed "at the mercy of verbalism" and that form should not be exalted over substance in the test of infringement (*Graver Tank*, 339 U.S. at 607), but we believe that the doctrine of equivalents should no longer be utilized as a means of implementing that principle because the doctrine fails to afford claims their assigned role in the statutory patent system.

We submit that, instead, the test of infringement should focus specifically on the claims themselves and, if the allegedly infringing device deviates from the claims in any respect, the inquiry should be whether that deviation is material in relation to the statutory function of the claims. More specifically, the proposed test can be formulated in terms of whether the questions involved in the patent issuance proceedings or in the determination of the patent's validity would have been different had the claims been written so as to cover literally the alleged infringing device. Only if the difference in the claims is sufficiently trivial so that either formulation of them would have presented essentially the same case in the issuance proceedings and in litigation of the patent's validity, should a finding of infringement be warranted. The measure of infringement

would, in essence, be the substance of the claims.[11] In light of the statutory safeguards which, in appropriate circumstances, enable patentees to state their claims comprehensively and to revise them to correct verbalistic deficiencies (see point II, *infra*), we believe that the proposed test would adequately protect the economic value of patents, while eliminating judicial expansion of the limited monopolies granted by the Patent Office. We recognize that this test would not obviate the need for the exercise of judgment in close cases. But we believe that it would provide guidance for such judgments that is both more in keeping with the congressional mandate and substantially more comprehensible than that provided by a doctrine characterized by the Court's admonition in *Graver Tank* that, "[i]n determining equivalents, things equal to the same thing may not be equal to each other and, by the same token, things for most purposes different may sometimes be equivalents" (339 U.S. at 609).

II

THE RIGHTS OF PATENTEES WOULD ADEQUATELY BE PROTECTED WITHOUT RETENTION OF THE DOCTRINE OF EQUIVALENTS

Replacement of the doctrine of equivalents by a standard of infringement compatible with more per-

[11] This is to be distinguished from the concept of protecting the "heart" or "gist" of patented inventions which has sometimes been said to justify the doctrine of equivalents. See *Keith* v. *Charles E. Hires Co.*, 116 F. 2d 46 (C.A. 2); *Frick Co.* v. *Lindsay*, 27 F. 2d 59 (C.A. 4). This concept, like the equivalents doctrine itself, improperly expands the scope of patent monopolies beyond the measure of the claims approved by the Patent Office. See *Aro I*, *supra*, 365 U.S. at 344–345.

The proposed test is also narrower than the standards governing

vasive federal patent policies would not sacrifice any legitimate rights or deserving equities of inventors. Built into the patent system itself are several alternative protective devices which are more carefully tailored than the doctrine of equivalents to achieve proper adjustment between the equitable needs of inventors and the pertinent policy considerations. Their availability assures that it would not be unfair for patentees' own claims to be the measure of infringement.

While, as previously noted, 35 U.S.C. 112 requires precise and definitive claiming (typically accomplished by professional claim drafting, see *supra*, p. 16, n. 10), it does not preclude appropriately comprehensive claiming. For example, if the inventor does not wish to restrict his claims to a single way of performing one step of the invention (or to a single device for one element of the patentable combination), he may instead claim a "means" as the third paragraph of Section 112 specifically authorizes.[12] To protect the public from the use of a "means" claim to stake out a monopoly broader than the patent applicant's disclosure, however, the novel aspect of the disclosure may not be described in general "means" terms (*Halliburton Co.* v. *Walker*, *supra*); nor may the means claim be so broad that

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reissue of patents under 35 U.S.C. 251 (see *infra*, pp. 20–21): its use, therefore, would not amount to judicial reissue of patents in evasion of that statutory provision.

[12] That paragraph provides as follows:

"An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof."

it covers every means for achieving the desired result (*O'Reilly* v. *Morse*, 15 How. 62).

Similarly, the discoverer of a "species" may claim the "genus" to which it belongs, subject to policy qualifications (see *Incandescent Lamp Patent*, 159 U.S. 465, 476). A genus may not be claimed where some of the species in it are inoperative for the desired purpose, *ibid.*; *Pemco Products, Inc.* v. *General Mills, Inc.*, 261 F. 2d 302 (C.A. 6); *American Chemical Paint Co.* v. *Firestone Steel Prod. Co.*, 117 F. 2d 927 (C.A. 6), or are already known or used by the public for such purpose. *In re Steenbock*, 83 F. 2d 912 (C.C.P.A.). But where a broad claim of this type is found by the Patent Office to be appropriate in view of the extent of the applicant's contribution, it will be allowed subject to the above qualifications. Moreover, the genus may even be an artificial one invented by the applicant,[3] provided a recognizable community of characteristics is discernible among the species to define their genus. *Application of Schechter*, 205 F. 2d 185 (C.C.P.A.). And where a new and inventive product cannot be defined in a claim other than by reference to the process of producing it, such claiming is proper. *In re McKee*, 95 F. 2d 267 (C.C.P.A.); *In re Butler*, 37 F. 2d 623 (C.C.P.A.).

Finally, if a patentee through honest error has claimed more or less than he had a right to claim in

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[3] A like rule permits the patentee to become his own lexicographer, transcending the limits of conventional language where this is necessary to describe the invention. *Autogiro* v. *United States*, 384 F. 2d 391 (C. Cl.); *Stuart Oxygen Co.* v. *Josephian*, 162 F. 2d 857 (C.A. 9); *Advance Ramley Co.* v. *John Lauson Mfg. Co.*, 275 Fed. 249, 251 (C.A. 7).

his patent, he may apply to the Patent Office (within two years of the original grant) for a reissue patent, to correct his mistakes in originally defining his invention (35 U.S.C. 251). In setting exacting standards for reissue patents, however, Congress has indicated that such enlargement of the claims of an already-issued patent should be confined to the circumstances prescribed by statute (*Keystone Bridge Co.* v. *Phoenix Iron Co.*, 95 U.S. 274, 278), as well as to a two-year time period. Moreover, and most importantly, Congress has guarded against prejudice to intervening rights of competitors, insofar as the reissued patent alters the claims of the original (35 U.S.C. 252).

The foregoing devices of the patent system are designed with specificity to assure fair protection of the inventor without prejudicing the public interest. All of them are consistent with the fact that Congress has placed administrative responsibility (subject to judicial review) in the Patent Office, as the expert agency to screen patent applications for novelty, utility, invention, and adequacy of disclosure and definition. By contrast, the doctrine of equivalents forces the State and federal courts[11] to assume the duties of the Patent Office (see Judge Hand's opinion in *Claude Neon Lights*, *supra*, 36 F. 2d at 575–576). This anomaly is unnecessary and unwarranted for the reasons we have shown. It debilitates and erodes the integrity of the patent examining system (*Graham* v. *John Deere Co.*, *supra*, 383 U.S. at 18); and it un-

[11] Cases similar to the present one can arise as contract actions in the State courts. Cf. *Lear, Inc.* v. *Adkins*, *supra*.

justifiably prejudices the interests of competitive manufacturers and the general public.

We urge the Court, therefore, to reject the doctrine of equivalents and to adopt, instead, the standard for determining patent infringement proposed in this brief (*supra*, pp. 17–18).[15]

CONCLUSION

For the foregoing reasons, the judgment of the court of appeals should be reversed.

Respectfully submitted.

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[15] In applying the proposed standard to the instant case, we believe that it would be appropriate for this Court to recognize that the specific reference to "a pair of spaced openings" in the claim at issue here (in lieu of a more comprehensive "means" claim) is the type of limitation in a claim that could well be designed to help induce its issuance or sustain its validity. Accordingly, it would be proper for the Court to hold that the patent was not infringed under the proposed test. We recognize, however, that the parties did not develop the record in this litigation with reference to the standard we have proposed and, for this reason, the Court may prefer to remand the case for a further hearing on the question of the application of the proposed standard to the facts of this case.